

REMARKS

Applicants acknowledge with appreciation the withdrawal of the 35 USC 112 rejection.

On this issue of priority, the Examiner asserts that Applicants are not entitled to the benefit of it parent application, 10/357,516, which is published as US 2004/0010259 A1. Specifically, the Examiner states:

The subject matter of application 10/357,516 **as originally filed** does not support the disclosure of the instant application. The foreign document EP 02 005 629.7 however does have subject matter related to Figures 1-5 of the current application. However, the foreign application was filed more than 12 months than [sic] the current application.

...

Therefore, for examination purposes, the current application will be examined as having a filing date of December 10th, 2003.

Applicants respectfully disagree. Due to an Office error, the application identified in PAIR as the February 4, 2003, parent application filing (and subsequently published as US 2004/0010259 A1) is not the originally filed parent application. Rather, as indicated by the publication number in the header, it comprises the body of 77 page PCT publication WO 01/62166 – a reference submitted in an IDS with the parent application. The parent application as originally filed comprised the 10 page German application, as evidenced by the application transmittal on PAIR and the stamped return receipt postcard as shown in the Appendix. An English translation and certified copy of the German application were subsequently filed on July 10, 2003 (as indicated in PAIR), and prosecution was based on that English translation.

Briefly stated, the parent application covers the subject matter of an instrument set for fitting and the corresponding implanting method, but does not cover the rasps as disclosed in connection with FIGS. 15-23 of the present application. Accordingly, all pending claims except for claim 20 are entitled to the filing date of the U.S. parent, and consequently, of foreign application EP 02 005 629, which was filed less than 12 months prior to the parent case.

Claims 1-7, 9-18, 21, 23, 24, and 25 remain rejected under 35 USC 102(b) on Michelson (US 6,159,214). This rejection is respectfully traversed. Claim 1 has been amended to recite an intervertebral plate comprising an X-ray marker *operable as an aiming line along an anterior-posterior axis*. Michelson does not disclose or suggest an intervertebral plate that comprises an X-ray marker operable as an aiming line along an anterior-posterior axis.

According to the first cited interpretation of Michelson, the Examiner states that the tip of the plate, the shoulder of the plate and bores can all act as x-ray markers. However, even if the cited elements act in the manner asserted the Examiner, the cited elements still fail to disclose an intervertebral plate that comprises an X-ray marker operable as an aiming line along an anterior-posterior axis. The bores are arranged on the milling block, not on the intervertebral plate as claimed. The tip is not visible in AP direction and thus is not operable as an aiming line as claimed. The shoulder is not visible in the assembled state of the instrument set, as shown in Fig. 12 for example, and thus is not operable as an aiming line as claimed. The shoulder is not visible during insertion and distraction because intervertebral plate 154 is narrower than circular knob 171. Consequently, even if the cited elements act in the manner asserted the Examiner, the cited elements fail to teach or suggest the elements required by claim 1. The same reasoning applies to the second cited interpretation of Michelson. In the third cited interpretation, the Examiner refers to bores (guide holes) on guide device 1110. Because these bores are not located on the intervertebral plate as claimed, they cannot anticipate claim 1. Claims 9 and 21 are not anticipated by Michelson for similar reasons.

Claim 16 recites a guide device which can be pushed onto the adjustment rod and which is *positioned* by the adjustment rod *via complementary surfaces* shaped to give a *non-rotational fit*. In contrast, guide device 700, cited for teaching the claimed guide device, is positioned by additional posts 734a and 734b rather than by a specific surface shape of the adjusting rod as claimed. Further,

the rod on which guide device 700 slides is circular, and therefore fails to give a non-rotational fit as claimed.

Claim 18 recites a cylindrical turning instrument, oriented with respect to guide axes of a guide device, configured to introduce two pins into vertebral bodies. A cylindrical turning instrument as claimed is neither taught nor suggested by Michelson. Further, claim 18 has been amended to recite a spreader instrument *configured to be connected to the pins to hold the pins parallel*. A spreader as claimed is also neither taught nor suggested by Michelson.

Claim 23 recites a guide device defining two guide axes made by through holes in a median plane above and below an adjustment rod. Guides axes as claimed are neither taught nor suggested by Michelson. While Michelson discloses through holes on milling block 700 or 1110, they are all offset to the left or right. In contrast, none of them is located in the median plane as claimed.

Accordingly, since Michelson does not teach the elements required by the claims, the rejection of claims 1-7, 9-18, 21, 23, 24, and 25 should be withdrawn.

Claim 20 stands rejected under 35 USC 102(b) on Hanson (US 2002/0068941). This rejection is respectfully traversed. Claim 20 recites cutting tools of *different sizes* that are configured to fit *an* intervertebral prosthesis into the intervertebral space. In contrast, Hanson discloses rasps configured to match the shape of a prosthesis (see para. [0111], 2nd sentence). There is no disclosure in Hanson of a set of rasps of varying sizes that are configured to fit one and the same prosthesis size. Further, claim 20 has been amended to recite that the largest rasp has a height substantially similar to that of the other rasps. Hanson does not teach or suggest a set of rasps of varying sizes, wherein each rasp has a substantially similar height. Claim 20 also recites rasps having a leveled surface without teeth. The portion of Hanson relied on by the Examiner for teaching this surface, outer wall 607 of FIG. 25, does not disclose a leveled surface as claimed. In contrast, Hanson expressly states in the last sentence of paragraph [0111] that the known rasps do have a teethed surface at the upper and lower level surface of the rasps.

Accordingly, since Hanson does not teach the elements required by the claims, the rejection of claim 20 should be withdrawn.

Claim 22 is rejected under 35 USC 102(b) on Buttermann (US 2003/0135217). This rejection is respectfully traversed. Buttermann discloses cutting into vertebral bodies, reaming the interior of the vertebral bodies, and creating an internal pathway between two vertebral bodies into which a prosthesis is implanted. In contrast, Buttermann does not disclose a step of removing an intervertebral disc as claimed. Rather, Buttermann discloses only to create a pathway through the intervertebral disc, which is different. Buttermann provides no disclosure of positioning an *intervertebral* plate as claimed. Buttermann provides no disclosure of an adjustment instrument having an *intervertebral* plate and an adjustment rod as claimed. Rather, Chisel 62 of Buttermann, on which the Examiner relies for teaching the adjustment instrument, is a chisel to create an opening in the vertebral *body*; it is never put into an *intervertebral space*. Lacking an adjustment instrument, Buttermann consequently fails to disclose sliding of a hub of a guide device onto an adjustment instrument as claimed. Buttermann does not disclose guide axes as being in a median plane as claimed. Rather, while cutting guide 20 of Buttermann provides holes defining guide axes as shown in the figures (e.g., FIG. 1A, 8), these holes are arranged to the left and the right, not in the middle (i.e. the median plane). Further, while Buttermann discloses a kind of distraction forceps, as shown in Figs. 17A and B, the forceps are not connected to the pins as claimed.

Accordingly, since Buttermann does not teach the elements required by the claims, the rejection of claim 22 should be withdrawn.

In view of the above, early action allowing claims 1-25 is solicited.

If the U.S. Patent and Trademark Office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and

authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. **246472003920**.

Dated: April 30, 2008

Respectfully submitted,

By Bradley J. Meier
Bradley J. Meier
Registration No.: 44,236
MORRISON & FOERSTER LLP
1650 Tysons Blvd, Suite 300
McLean, Virginia 22102
(703) 760-7700

attachment: stamped return receipt postcard from parent application 10/357,516

APPENDIX

ATTORNEY DOCKET: 246472003900
INVENTOR(S): Arnold KELLER et al.
TITLE: CERVICAL PROSTHESIS AND INSTRUMENTATION THEREFOR
Papers enclosed:

DATE: February 4, 2003
Atty/Secy: BEB/jfm

- | | |
|--|---|
| <input checked="" type="checkbox"/> TRANSMITTAL UNDER 1.53 B | <input type="checkbox"/> SMALL ENTITY DECLARATION (2) |
| <input type="checkbox"/> FEE TRANSMITTAL | <input checked="" type="checkbox"/> APPLICATION DATA SHEET 2 PAGES |
| <input checked="" type="checkbox"/> GERMAN LANGUAGE SPECIFICATION,
CLAIMS AND ABSTRACT 9 PAGES
W/DRAWINGS (1 SHEET, FIGURES 1-5) | <input type="checkbox"/> PRIORITY TRANSMITTAL W/2 CERTIFIED
DOCUMENTS |
| <input type="checkbox"/> DECLARATION (2PAGES) (COPY)
<input type="checkbox"/> SIGNED / <input type="checkbox"/> UNSIGNED | <input checked="" type="checkbox"/> IDS W/FORM 1449 W/ 3 REFERENCES and EP
SEARCH REPORT |
| <input checked="" type="checkbox"/> ADVANCED SERIAL NUMBER CARD | <input type="checkbox"/> ASSIGNMENT W/ COVER SHEET |

DUE 03/12/2003

JC971 U.S. PTO

10/357516



02/04/03

RECEIVED BY THE UNITED STATES PATENT AND TRADEMARK OFFICE